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S&H Form: (2/01)

Docket No.: 1293.1157

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Byoung-ho CHOI et al.

Serial No. 09/727,469

Group Art Unit: 2878

Confirmation No. 4374

Filed: December 4, 2000

Examiner: Paul W. Huber

For: METHOD AND APPARATUS FOR DETERMINING A TYPE OF DISK

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed January 28, 2004, having a shortened period for response set to expire on February 28, 2004, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group I, claims 1-15 and 20-37, in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 16-19 and 38-40 are so closely related to elected claims 1-15 and 20-37 that they should remain in the same application. The elected claims 1-15 and 20-37 are directed to a method and apparatus for determining a type of disc in an optical disc recording/reproducing device and claims 16-19 and 38-40 are drawn to a method and apparatus to generate a track cross signal in an optical disk recording/reproducing apparatus. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the product and method claims, it is

believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)-§806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

The Applicants respectfully request the Examiner to consider claims 1-15 and 20-37 (Group I) and 16-19 and 38-40 (Group II) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the method recited by the claims 16-19 and 38-40 are drawn to a method and apparatus to generate a track cross signal in an optical disk recording/reproducing apparatus, and elected claims 1-15 and 20-37 are directed to a method and apparatus for determining a type of disc in an optical disc recording/reproducing device, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 02/23/2004

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